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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,615	01/20/2004	Avner Yayon	81408-4600	3532
28765	7590	04/29/2005	EXAMINER	
WINSTON & STRAWN LLP 1700 K STREET, N.W. WASHINGTON, DC 20006			BARNHART, LORA ELIZABETH	
			ART UNIT	PAPER NUMBER

1651

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/761,615

Applicant(s)

YAYON ET AL.

Examiner

Lora E. Barnhart

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13 and 50, drawn to a freeze-dried biocompatible porous matrix, classified in class 424, subclass 93.7.
- II. Claims 14-22 and 47, drawn to a method for preparing a porous matrix of plasma proteins, classified in class 424, subclass 93.7.
- III. Claims 23-33, drawn to a method for preparing and implanting *in vivo* a porous scaffold, classified in class 424, subclass 93.7.
- IV. Claims 34-46, drawn to a method for preparing and implanting *in situ* a porous scaffold, classified in class 424, subclass 93.7.
- V. Claims 48 and 49, drawn to a method for treating injured tissue, classified in class 424, subclass 93.7.

The inventions are distinct, each from the other because of the following reasons:

Groups II-V are directed to methods that are distinct both physically and functionally, and are not required one for the other. Groups III and IV include cutting and implantation steps not recited or implied by Group II. Group II prepares a "porous matrix", while Groups III and IV prepare a "porous scaffold". Groups III and IV are divergent because Group III is related to implants *in vivo*, while Group IV is related to implants *in situ*. Group V is a method of using, while Groups II-IV are methods of preparing compositions that are not necessarily required by Group V. Therefore, a

search and examination of all three methods in one patent application would result in an undue burden, since the searches for the methods are not co-extensive, the classification is different, and the subject matter is divergent.

Invention I is unrelated to Inventions II-V. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to a composition and four methods that do not necessarily prepare or use said composition. There are limitations within Group I (e.g. fibrin content) that are not recited in the methods of Groups II-IV and V.

Because these inventions are distinct for the reasons given above and the literature search required for any Group is not required for any other Group, restriction for examination purposes as indicated is proper. Burden consists not only of specific searching of classes and subclasses, but also of searching multiple databases for foreign references and literature searches. Burden also resides in the examination of independent claim sets for clarity, enablement and double patenting issues.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Auxiliary components: (a) polysaccharides, (b) anionic polysaccharides, (c) glycosaminoglycans, and (d) synthetic polymers, as in claims 6, 20, 29, and 40.

Additional auxiliary components: (e) hyaluronic acid, (f) pectin, (g) alginate, (h) galactans, (i) galactomannans, (j) glucomannans, (k) polyuronic acids, (l) heparin, (m)

Art Unit: 1651

chondroitin sulfate, (n) dextran sulfate, (o) dermatan sulfate, (p) heparan sulfate, (q) keratan sulfate, (r) hexuronyl hexosaminoglycan sulfate, (s) inositol hexasulfate, (t) sucrose octasulfate and (u) PEG, as in claims 7, 8, 21, 22, 30, 31, 41, and 42.

Cell types: (v) chondrocytes, (w) osteocytes, (x) hepatocytes, (y) mesenchymal cells, (z) epithelial cells, (a') urothelial cells, (b') neuronal cells, (c') pancreatic cells, (d') renal cells, and (e') ocular cells, as in claims 10, 32, and 44.

Bioactive agents: (f') growth factors, (g') cytokines, (h') enzymes, (i') anti-microbials, and (j') anti inflammatory agents, as in claims 12, 33, and 43.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. That is, if any of Groups I-IV be elected, applicant should elect ONE auxiliary component, ONE additional auxiliary component, ONE cell type, and ONE bioactive agent. If an additional auxiliary component is elected that is not recited in claims 8, 22, 31, or 42, the appropriate claim of 8, 22, 31, or 42 will be withdrawn by the examiner. Currently, claims 1-50 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

Art Unit: 1651

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of M.P.E.P. § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 C.F.R. 1.116; amendments submitted after allowance are governed by 37 C.F.R. 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 C.F.R. 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. §§101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to maintain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the protection against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See M.P.E.P. § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lora E. Barnhart whose telephone number is 571-272-1928. The examiner can normally be reached on Monday-Friday, 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit: 1651

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Lora E Barnhart



**SANDRA E. SAUCIER  
PRIMARY EXAMINER**